REMARKS/ARGUMENTS

Claims 47, 48, 50, 52, 53, 55-61, 63-65, 67 and 68 are pending in the application and stand rejected. Claims 47, 48, 50, 52, and 53 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Martinez '229. Claims 55-57, 59-65, 67 and 68 stand rejected under 35 U.S.C. § 103(a) as being directed to subject matter that would have been obvious from Martinez '229 in combination with Heckel '601; and claim 58 stands rejected under § 103(a) as being directed to subject matter that would have been obvious from Martinez '229 in combination with Heckel '601 and Archibald '883. For the reasons explained below, Applicant respectfully submits that the rejections are erroneous and should be withdrawn.

In the following sections we provide discussion focused mainly on the primary reference, Martinez '229, showing why this reference fails to support the rejection of claims 47, 48, 50, 52, and 53, in that it lacks disclosure of certain key limitations recited by independent claim 47. This discussion also supports our argument that the Office action does not make out a *prima facie* case of unpatentability with respect to the claims 55-61, 63 - 65, 67 and 68.

Examiner Interview Request

Should the examiner feel that the present Response to the Office action is not sufficient to overcome the rejections, or if he feels that an interview would be helpful to advance prosecution for any other reason, Applicant's undersigned attorney invites the examiner to call him directly at 206-332-1384 to arrange a telephonic interview.

Legal Framework

A rejection based on 35 U.S.C. § 102(e) requires that each and every limitation of each rejected claim be disclosed (explicitly or inherently) by the asserted reference (in this case, Martinez).

A rejection based on 35 U.S.C. §103 is authorized "where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references."[1] When applying 35 U.S.C. §103, the examiner must adhere to the basic tenets of patent law:

    A. The claimed invention must be considered as a whole;

    B. The references must be considered as a whole and must suggest the desirability of making the combination;

    C. The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and

    D. Obviousness must be determined under a reasonable expectation of success standard.[2]

In order to establish a *prima facie* case of obviousness, the examiner is required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference, or combination of references, must teach or suggest all the claim limitations.[3] The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To make a proper obviousness

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1 M.P.E.P. § 706.02(j).
2 M.P.E.P. § 2141.
3 *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. §§ 2143 - 2143.03.

determination, the examiner must "step backward in time and into the shoes worn by the

hypothetical 'person of ordinary skill in the art' when the invention was unknown and just

before it was made."[4] In view of the available factual information, the examiner must make a

determination as to whether the claimed invention "as a whole" would have been obvious at

that time to that person skilled in the art. Importantly, a rejection based on these criteria must

be based on what is taught in the prior art, not the applicant's disclosure.[5] The applicant's

disclosure may not be used as a blueprint from which to construct an obviousness rejection.[6]

We will now address the specific rejections set forth in the Office action.

The Rejections Under 35 U.S.C. §§ 102(e) and 103(a)

In connection with claims 47, 48, 50, 52 and 53, the Office action states that the

Martinez '229 patent (hereafter, Martinez) teaches "a computer transaction system for

obtaining digital objects (i.e. second set of rules) for use in a gaming environment ... (column

3, lines 1-50; column 4, lines 32-64; column 8, lines 13-48; column 29, lines 29-60)." More

specifically, the Office action states that Martinez teaches the following:

- "Users obtaining (i.e. cheating) digital objects or specific characteristics (e.g. spells, abilities) for use in a game outside of 'normal' (i.e. first set of rules) gameplay (figure 9; column/line 5/59-6/36; column 8, lines 13-48), where the process of obtaining the digital objects or second set of rules is equivalent to requesting the second set of rules during 'a game session' (abstract; column 4, lines 38-64)";

- "executing the transactions, as well as, tracking, tallying, storing of executed transactions and performing billing associated with the transactions (e.g. aggregated while the game is being played, on a per-user basis) (column/line 15/42-16/17; column/line 16/47-18/9; column/line 20/20-21/11; column 21, lines 58-67)."

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4 M.P.E.P. § 2142.
5 *Id.*
6 *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985); *Orthopedic Equipment Company v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed. Cir. 1985); *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996).

The Office action also states: "Note, a transaction represents a user accessing (or purchasing) the digital object or second set of rules."

The Office action acknowledges that Martinez does not teach advertising objects or second set of rules during game play, and proposes to supplement Martinez with Heckel's teaching of advertisement within a gaming environment. In addition, the Office action acknowledges that Martinez lacks disclosure of the different types of communications networks recited in some of Applicant's dependent claims, and proposes to supplement the Martinez/Heckel combination with Archibald's disclosure of tracking computer usage of digital objects across a remote network and charging users on a per-use basis. Again, however, we respectfully submit that the three references relied upon in the Office action lack any teaching or suggestion of certain limitations of Applicant's claims, which are discussed in detail below.

In the remarks below, we first summarize Applicant's claimed invention as defined by the independent claims. We then examine the subject matter disclosed by Martinez, and then we compare/contrast portions of the Martinez patent relating to gaming, including those portions specifically applied by the Office action, with the limitations recited by Applicant's claims. We also rebut the examiner's conclusion that Martinez anticipates the claimed invention. In view of these remarks, we respectfully urge the examiner to reconsider the present application and to withdraw the rejections under 35 U.S.C. §§ 102(e) and 103(a). One major reason for withdrawing the rejection is that Martinez, and the other art, lacks any teaching or suggestion of the "integrating" aspect of Applicant's invention, i.e., the aspect of the claimed invention relating to integrating a mechanism for providing access to a second set of rule to permit the player to purchase the ability to "cheat" or obtain an advantage not

normally available in the game. (For example, claim 47 recites the step of "integrating within

the game a mechanism providing a second set of rules, wherein the second set of rules allows

for the first set of game rules to be cheated, wherein the second set of rules is only accessed

through a transaction entailing the exchange of consideration".)

A. Applicant's Claimed Invention

Applicant's invention is current claimed in three sets of claims, with claims 47, 55

and 63 being the respective independent/base claim for each set. Claims 47 and 63 are

directed to methods, and claim 55 is directed to a game system "module".

More particularly, claim 47 is directed to "a method for facilitating a game player's

cheating of the first set of game rules," as used in "an interactive computer-based game

having a first set of game rules that is played via a computer." The claim recites the step of

"integrating within the game a mechanism providing a second set of rules, wherein the

second set of rules allows for the first set of game rules to be cheated, wherein the second set

of rules is only accessed through a transaction entailing the exchange of consideration." In

addition, claim 47 recites the steps of "providing a dynamic mechanism whereby a game

player, during a game playing session, may employ the dynamic mechanism to request access

to the second set of rules," as well as "executing the transactions resulting from the received

requests, thereby enabling the game player to circumvent, or cheat, the first set of game rules,

in accordance with the second set of rules, in exchange for said consideration." Thus,

integration of the "cheating" mechanism as well as obtaining consideration in exchange for

access to the second set of rules are specifically claimed aspects of the invention defined by

claim 47.

Claim 55 is directed to "a module allowing for the cheating, or circumvention, of the game rules through the execution of a second set of rules such that access to the second set of rules is only accomplished through a transaction wherein consideration is exchanged." The claim further calls for "an integration object, the integration object providing seamless integration between the module and the game such that the second set of rules operate in the game to allow cheating of the first set of rules." In addition, claim 55 requires "a transaction object, the transaction object being dynamically operative during game play to identify instances in which to offer a player the opportunity to access a rule from the second set of rules, to thereby obtain an advantage vis-à-vis the first set of game rules, and for transacting instances where the second set of rules are accessed."

Claim 63 recites "a method to allow cheating through a transaction, wherein the transaction entails the exchange of consideration." This claim recites the steps of "creating a second set of rules that cheat the game set of rules, wherein access to the second set of rules is only realized through the execution of a transaction"; and "integrating in the computer game the second set of rules . . . ."

B. Martinez '229

The Martinez patent, which is entitled *Virtual Property System*, discloses a so-called "digital object ownership system" that includes a plurality of "digital objects." Each of the digital objects is described as having a unique object identification code, and as being assigned to an owner. The digital objects are said to have "utility in connection with communication over a network in that the object requires both the presence of the object identification code and proof of ownership." Martinez '229, Abstract.

In the Background section, Martinez discusses the use of computer networks for

communication and data processing, and the increased use of computer networks for new

kinds of business transactions and similar interactions, such as banking or retail transactions,

and interactive, multi-party games. Martinez says that it may be "desirable to eliminate

certain perceived 'advantages' or inherent features of the new medium, and extend familiar

limitations of the physical world into the electronic realm." Col. 1 lines 57 – 60. More

specifically, Martinez suggests that, in the case of digital cash, it is necessary to prohibit

"counterfeiting," and that this is accomplished "by introducing digital equivalents of the

security features that protect against counterfeit paper currency." Col. 1 lines 60 – 64. Going

further, Martinez states that traditional features and limitations of ownership and property

rights may be desirable in an interactive game environment, for example, "users might

purchase or otherwise obtain 'property' which can be voluntarily or involuntarily transferred

to other users." Col. 1 line 65 – co. 2 line 3.

In the Detailed Description section of the patent, Martinez describes a system

including an application service provider, which could be a game specific service provider, as

well as a so-called Transactor system. In the example described, the application service

provider is said to comprise a game server, and the end-users comprise game clients. End

users are described as interacting with one another and with a game server over a computer

network in a "virtual world" (an interactive environment governed by a prescribed set of

rules) provided by the game server and supported by the Transactor server. In this "virtual

world," digital property can be owned by, used, and transferred among end users. See

Overview subsection, col. 2 line 65 – col. 3 line 44.

The Transactor servers are described as defining "a marketplace in which safe

transactions may occur, and existence and ownership may be asserted and verified under

rules (i.e., "Transactor Laws of Nature") defined for the Transactor system as a whole." Col.

4 lines 8 – 12. "The primary purpose of the Transactor system is to provide a safe

marketplace for objects and owners outside the scope of any game in which those objects and

owners might participate." Col. 4 lines 12 – 14. The patent states that, "if a potential game

does not require its game objects to exist outside the scope of its game universe, then using

Transactor to determine authenticity and ownership is not necessary. It may, however, be

more convenient or easier to use Transactor services than to create a special-purpose property

ownership and transfer system for that game." Col. 4 lines 14 – 20. (**This makes it clear that**

the Transactor aspect of the system is not integrated with the game server.) Also, with

respect to "cheating," Martinez says that a given Transactor server "is responsible for the

objects and users defined in its own database" and "trusts other Transactor servers for

validation of all other objects and users"; and that it can "detect certain kinds of cheating that

might occur in its conversations with those other Transactor servers." Col. 4 lines 21 – 26.

With regard to the Game Servers, Martinez says that, to a Transactor server, a game

server is a Transactor user that performs transactions and limited types of authentications.

(Again, the Transactor plays the role of a server to a game server, which in this case is a

client of the Transactor.) Among themselves, Martinez says that game servers define a virtual

world for their clients, and "operate on a set of game objects using game rules that the game

designer defines for that game." Col. 4 lines 41 – 45.

In the subsection entitled "Limited Edition Digital Object" (col. 8 lines 11 – 47),

Martinez discloses that the Transactor system allows for the ownership and sale of limited

edition digital objects (LEDOs). The Martinez patent discloses that a LEDO 600 (see FIG. 8) comprises a payload 606, a unit ID 602, and an owner ID 604, and that examples of LEDOs for use in a game environment comprise "tools, characters, keys, spells, levels, abilities, behaviours." Col. 8 line 23. Aside for this brief mention, Martinez does not seem to say any more about keys, spells, levels, abilities, etc., or how they might be purchase outside of normal game rules.

Game Servers are described in the subsection at Col. 10 lines 12 – 29. The patent states that Game Servers "trust their Transactor Servers to perform valid ownership transfers, and to correctly authenticate user-accounts and object ownership."

With regard to Game Users, Martinez says that they "trust game servers to 'play a fair game' (i.e., follow the rules of the game universe). Game servers that do not play a fair game are unlikely to be successful in the game market, but there is no final Transactor arbiter of what constitutes a 'fair game.'" Col. 10 lines 31 – 39. Here again, it seems that Martinez lacks disclosure of, and in facts teaches away from, the concept of "paying to cheat" or an integrated mechanism to allow a player to circumvent the normal rules by purchasing advantages within the gaming environment.

In the subsection entitled Transactor Brokering, beginning at col. 10 line 40, Martinez describes how objects may be bought, sold, and traded using a broker "in order to effect transactions in other than real-time." Col. 10 line 46. A typical problem involving a game, game-players, and ownership transfer is presented, and this is followed by a "simple solution" and then a discussion of "brokers, their actions, rules, and how this solves the basic ownership-transfer problem when implemented in more complex embodiments of a Transactor system." Col. 10 lines 49 – 56. In the description of "An Exemplary Game

Scenario and Implementation Problem," Martinez discusses a simple multi-player game

running on a server machine, wherein players own some Transactor objects, which reside on

their own machines, and wherein a few players decide to play a game using some (but not all)

of their owned objects, using the game server to run the "game world." Col. 10 lines 59 – 64.

> The rules of this game allow game objects (encapsulated as Transactor objects
> and initially existing on the player's machines) to be involuntarily "plundered"
> by the brute force or trickery of any player, as well as voluntarily traded away,
> or simply lost or dropped. In this game, possession equals ownership. Lost or
> dropped objects not picked up by another player are "owned" by the game (or
> game service provider). A Transactor server is contacted and a transaction (a
> Transactor ownership transfer) made each time a game-object changes
> ownership, (e.g., it is plundered, traded away, lost, dropped).

Col. 10 line 64 – col 11 line 6.

Martinez explains the "basic problem" of "how a game server or anyone else in the

above scenario can truly enforce transferring ownership involuntarily; that is, without the

active assent of the object's original owner." "Under ordinary circumstances, the owner

cannot be compelled to use or disclose his private key and, without it, ownership cannot be

taken away. Even if the game-client software running on the player's machine automatically

responded to a game server request to transfer ownership, the user could have hacked the

software to not permit ownership transfers. Thus, in conventional circumstances, the game

server would have no way to enforce ownership transfer to the object's new owner." Col. 11

lines 11 – 27. Martinez then goes on to describe a "Simple Solution" (see subsection

beginning at col. 11 line 57). The examiner is respectfully invited to review this solution in

detail, but it seems that the essence of the Martinez solution is as follows: A game player may

give a "power of attorney" privilege to a game server during game play, and then rescind it

when the game ends or the player withdraws from play. Alternatively, in a solution involving

Brokers (see subsection beginning at col. 12 line 49), a Broker operates on an object and acts

as an intermediary in transferring ownership between the original owner and the buyer.

"Users (players) in the Brokering Game participate voluntarily, and willingly transfer

ownership of their objects to the broker with the understanding that they will get them back if

the broker does not sell the object." Col. 13 lines 3 – 6.

Another aspect of the Martinez system includes a Bookkeeper that "receives,

confirms, and logs all transactions and transfers of objects; maintains accounts (distributes

splits to other users, etc.); and performs collect-and-forward transactions to other mercantile

servers (bank-cards and bank-deposits)." Col. 16 lines 59 – 63.

In the subsection entitled "Objects and Cheating," beginning at col. 27 line 34,

Martinez states that it is desirable to resist several kinds of cheating, including unauthorized

creation and transfer of objects. Similarly, in "Modes of Play" (col. 29 lines 29 – 60),

Martinez describes a security system and four basic modes of play, including: (1) Server-

Mode, wherein each player interacts constantly with the server; and (2) Proxy-Mode, wherein

a proxy is used and the proxy "will prevent unwarranted creation, destruction, and alteration

of objects in the local game, and will try to guarantee that no cheating done in the local game

(even involving all participants) can allow cheating in the global game."

C. Differences Between the Claimed Invention and the Prior Art

We will now address each of Applicant's independent claims and show why Martinez

fails to anticipate the claimed subject matter. For the same reasons, we respectfully submit

that Martinez in combination with the other art of record fail to render the claimed obvious.

Claims 47 – 53

As already discussed, claim 47 recites the step of: "integrating within the game a mechanism providing a second set of rules, wherein the second set of rules allows for the first set of game rules to be cheated, wherein the second set of rules is only accessed through a transaction entailing the exchange of consideration." There is no teaching or suggestion of this step in the art of record (including Martinez). As discussed above, Martinez discloses a Transactor system in which clients (such as a game server) may employ the Transactor to manage property rights with respect to digital objects, particularly when it is necessary to maintain such rights **outside of the game environment**. Nowhere does Martinez suggest integrating a mechanism within the game to allow players to transact advantages ("pay to cheat") while playing the game. If the examiner feels that Martinez does teach or suggest this limitation, we respectfully ask the examiner to specifically cite to such teaching in the Martinez patent. Absent such specific teaching, the rejection under Section 102(e) must fail.

Claim 48 depends from claim 47 and adds the step of "tracking the executed transactions." Claim 50 depends from claim 48 and specifies that the step of tracking the executed transactions comprises the steps of: tallying the number of executed transactions, and storing the number of executed transactions." Claim 52 depends from claim 50 and adds the steps of "associating bill amounts for each instance the second set of rules is accessed, wherein the bill amounts depend on which rule of the second set of rules is being accessed; and aggregating the bill amounts based on the tallied executed transactions." These claims all recite further details of a preferred implementation of the system defined by claim 47, and are allowable over the art of record for the reasons discussed above in connection with claim 47 (in short, integrating the ability to pay to cheat) and further because of the additional limitations recited. For example, claim 52's recitation of "associating bill amounts for each

instance the second set of rules is accessed, wherein the bill amounts depend on which rule of

the second set of rules is being accessed" is not even address in the Office action, and

Applicant's attorney could find no hint of this in the prior art..

Claims 55 – 62

Claim 55 is similar to claim 47 in respect of its requirement for an "integration

object," which is defined functionally as "providing seamless integration between the module

and the game such that the second set of rules operate in the game to allow cheating of the

first set of rules." In addition, claim 55 recites a "transaction object," which is also defined

functionally, in this case as "being dynamically operative during game play to identify

instances in which to offer a player the opportunity to access a rule from the second set of

rules, to thereby obtain an advantage vis-à-vis the first set of game rules, and for transacting

instances where the second set of rules are accessed." Neither of the above limitations is

disclosed by Martinez or the other art of record. Again, should the examiner disagree, he is

respectfully asked to cite to specific column and line numbers of the Martinez patent where

such teachings are contained.

Claim 56 depends from claim 55 and adds a "communication object" defined as

"having at least one instruction to instruct the game to communicate information

representative of cheating operations to a cooperating computing environment." Claim 57

depends from claim 56 and specifies that the communication of the cheating operations

information is communicated over a communications network, and claim 58 depends from

claim 57 and specifies that the communication network comprises any of a plurality of

different types of network. Claim 59 depends from claim 55 and specifies that the transaction

object "keeps a running tally of executed transactions, associates bill amounts to each

transaction, and aggregates the bill amounts for all of the transactions." Claim 60 depends

from claim 59 and adds "at least one instruction to instruct the game to communicate the

aggregated bill amounts to a cooperating computing environment and/or to a display device."

Claim 61 depends from claim 59 and adds that "the bill amounts are aggregated while the

game is being played." Finally, claim 62 depends from claim 61 and recites that the bill

amounts "are aggregated on a user basis."

Again, these dependent claims recite further details of a preferred implementation of

the system defined by base claim 55. We respectfully submit that these dependent claims are

allowable over the art of record for the reasons discussed above in connection with claim 55

as well as because of the additional limitations recited.

Claims 63 – 68

Claim 63 is directed to a "method to allow cheating through a transaction, wherein the

transaction entails the exchange of consideration," comprising the steps of "creating a second

set of rules that cheat the game set of rules, wherein access to the second set of rules is only

realized through the execution of a transaction"; and "integrating in the computer game the

second set of rules, wherein the integrating step entails dynamically monitoring progress of a

game playing session and offering one or more of the second set of rules as the game is being

played." The integrating/transacting limitations are similar to the limitations discussed above

in connection with other claims, and we respectfully submit that the prior art of record does

not teach or suggest these limitations.

Dependent claims 64 through 68 recite additional limitations similar to those already

addressed in connection with the other dependent claims, and so we will not discuss them

again, except to ask the examiner to reconsider his finding that these limitations are taught in

the art of record.

CONCLUSION

For all of the foregoing reasons, the rejections should be withdrawn and a Notice of

Allowance for claims 47, 48, 50, 52, 53, 55-61, 63-65, 67 and 68 is respectfully requested.

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Michael D. Stein
Registration No. 34,734

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439